

II. Claims Rejections - 35 U.S.C. § 103

The Examiner has rejected claims 1-9 under 35 U.S.C. 103(a) as being unpatentable over Jackson *et al.* (US 2002/0105658) [“Jackson”] in view of Fredlund *et al.* (US 5,66,215) [“Fredlund”]. For at least the following reasons, Applicant traverses the rejection.

Claim 1 recites a data management method that comprises “displaying on a display means an icon corresponding to a data management unit with which data can be registered; registering the data with the data management unit by carrying out a drag-and-drop operation for the data onto the icon; and carrying out a simple output of the data registered with the data management unit to the display means by opening the icon.”

The Examiner contends that Jackson discloses the claimed displaying on a display means an icon corresponding to a data management unit with which data can be registered.

Specifically, the Examiner cites paragraph 39 lines 1-6 of Jackson, which states:

In block 105 of FIG. 2, the customer selects images to be uploaded from the home computer 10 to the fulfillment center 40, in order to be stored by the service provider, and possibly utilized in the future to produce one or more photo products. In a preferred embodiment, the CPU 12 displays on the display monitor 14 a display screen 400 as shown in FIG. 7.

The Examiner contends that the above paragraph “teaches displaying on screen a set of data that is to be selected, and also the use of icons that represent digital images on a computer. In performing the image group access, icons that refer to the set will be used.” Office Action at page 2. The Examiner goes onto clarify in the response to arguments section that “data is registered with an icon that Jackson would use to call up a set of data (for Jackson’s system uses the iconic metaphor throughout), and it is Fredlund that is relied upon to show drag-and-drop registration such as would obviously use such a ‘folder’ icon as a target. This object, moreover,

would represent the claimed 'data management unit' because of its organizing capability.”

Office Action at page 6.

Applicant respectfully requests that the Examiner clarify his statement regarding the “folder icon” since there is no reference to “folder icons” or their “organizing capabilities” in either Jackson or Fredlund. Since the Examiner has not provided any prior art support for his contention that a “folder icon” has features corresponding to the claimed features, Applicant submits that the Examiner’s speculations are not evidence in the record as required by the MPEP. See MPEP at 2100-136 to 2100-137.

In addition, Applicant requests clarification of the contention that “[i]n performing the image group access, icons that refer to the set will be used.” To the extent the Examiner may be contending that access to display screen 400 is by an icon, Applicant submits that there is no support in Jackson for this contention. Accordingly, these speculations are also not evidence in the record.

As best understood, based on the cited sections and the Examiner’s comments, the Examiner contends that the thumbnail images 402, which represent image data, in Fig. 7 correspond to the claimed icon corresponding to a data management unit with which data can be registered since these thumbnail images 402 may be selected for registering with the fulfillment center 40. Also, based on the cited section, the Examiner contends that uploading image data, which corresponds to the thumbnail images, to the fulfillment center 40 corresponds to the claimed data registration, and that the fulfillment center 40 corresponds to the claimed data management unit.

Jackson discloses a display screen 400 that displays thumbnail images 402 of data in a digital camera, CD reader or hard drive. The thumbnail images are selected by using a mouse 18 in order to be uploaded to a fulfillment center 40, which is a service center, for further processing of the image data. The selected mages may be uploaded immediately upon selection by the user or at a later time. See paragraphs 0039-0042.

Applicant submits that Jackson does not disclose or suggest “displaying on a display means an icon corresponding to a data management unit” as set forth in claim 1. The Examiner’s contention that using the thumbnail images 402 to register data would fulfill this requirement is not supported by the disclosure in Jackson. Jackson clearly discloses that these thumbnail images represent data at the user’s location, not icons that correspond to the fulfillment center 40 (alleged data management unit). The Examiner’s further contention that “Jackson’s system uses the iconic metaphor throughout” is irrelevant to the issue at hand since there is no disclosure or suggestion in Jackson of displaying an icon corresponding to the fulfillment center.

In addition, the claimed icon has the capability of registering data by having data “dropped” onto it by using a drag-and-drop operation. To meet the claimed features, the thumbnail images would need to be “dragged” and “dropped” onto an icon that registered the image with the fulfillment center. Accordingly, even if the thumbnail image of Jackson were modified to accept data from a drag-and drop operation, the result would be meaningless since the thumbnail image cannot be “dragged” and “dropped” onto itself.

Therefore, Applicant submits that, contrary to the Examiner’s contentions, Jackson does not disclose or suggest “displaying on a display means an icon corresponding to a data

management unit with which data can be registered” as set forth in claim 1. Fredlund does not cure this deficiency.

Fredlund is relied upon by the Examiner to teach the claimed drag-and-drop operation for the data to be registered onto the icon, which represents the data management center. The Examiner’s cited section of Fredlund states:

The customer then identifies one of the images using a standard drag and drop computer interface or set-top box selection mode, for example by clicking on one of the images with a mouse or trackball and dragging it into the large display area 56, or by entering the desired frame number on a remote control device if the program is implemented via a set-top box.
Col. 5, lines 38-44 (emphasis added).

Applicant submits that the Examiner’s reliance on Fredlund to teach drag-and-drop onto an icon is misplaced since the cited section merely describes that data may be dragged onto a displayed screen, not dragged onto an icon. Accordingly, Jackson in view of Fredlund still would not teach the claimed drag-and-drop operation for the data to be registered onto the icon.

In addition, the Examiner contends that the dragging onto the large display area as disclosed by Fredlund still corresponds to the claimed registering “when ‘registering’ is given a reasonably broad interpretation.” Office Action at page 6.

Applicant submits that, although a reasonably broad interpretation of registering is permissible, it is not permissible to shift the interpretation of a claim term within the claimed elements. Here, the Examiner uses the uploading of images to a fulfillment center to initially register the image data to contend that Jackson discloses the claimed registration, then the Examiner improperly shifts the meaning of registration to correspond to the displaying of images.

To be consistent in the analysis, the Examiner must use information related to the initial scanning and storing of the images by the photo finisher (see col. 2, lines 28-34 of Fredlund) to support any contentions that teachings related to registration between Jackson and Fredlund are combinable. Because Fredlund does not disclose or suggest a drag-and-drop operation onto an icon in the context of initially registering data, Applicant submits that the teachings of Fredlund are not applicable to the registering operation in Jackson. Accordingly, the Examiner's proffered reason for combining the references is not supported.

Claim 1 also recites "carrying out a simple output of the data registered with the data management unit to the display means by opening the icon." The Examiner contends that the displaying of images that have been uploaded in Jackson corresponds to the claimed carrying out a simple process. The Examiner also contends that "[t]he initial group selection via icon that occurs in Jackson has the result of opening a displayed group of sub-icons for the images."

Office Action at page 3.

Applicant submits that, at best, Jackson discloses that a display "similar to the display screen 400" can be used to display thumbnail images of the uploaded image data (paragraph 0049). Contrary to the Examiner's contentions, there is no disclosure or suggestion that the display screen is opened by using an icon that is used to register the image data. In fact, there is no disclosure or suggestion that any icon is used to open the display screen. The Examiner's contention that Jackson discloses an initial group selection via icon is mere speculation since it is not supported in the prior art.

Accordingly, for at least the reasons given above, Applicant submits that the Examiner has not made a *prima facie* case of obviousness with respect to claim 1.

Because claims 4 and 7 recite features similar to those given above with respect to claim 1, Applicant submits that these claims are patentable for at least reasons similar to those given above with respect to claim 1.


Applicant submits that the remaining claims are patentable at least by virtue of their respective dependencies.

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


Bhaskar Kakarla
Registration No. 54,627

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: September 13, 2005